

REMARKS

Claims 1 and 3-20 remain active in this application. Restriction has been required between Groups I-V in this application. The restriction requirement is respectfully traversed. Group I, Claims 1-2, are drawn to substituted quinolonecarboxylic acids, and Groups II-V are drawn to a process for the synthesis of these compounds. Thus Groups I and II-V are related as product and process of making.

Such a restriction does not appear to be proper since specific provisions is set forth in the Patent and Trademark Regulations which allow at minimum a product, process of synthesizing that product and one use of that product to be present in the same application. As stated in 37 CFR 1.141(b):

A group of claims of different categories in an application so linked as to form a single inventive concept are considered to be one invention. In particular, any of the following groupings of claims of different categories may be included in the same application;

- (1) in addition to a claim for a given product,
 - (i) a claim for one process specially adapted for the manufacture of the said product, as where the process of making as claimed cannot be used to make other or materially different products;
 - (ii) a claim for one use of the said product, as where said use as claimed cannot be practiced with another materially different product; or

(iii) both (b)(1)(i) and (ii).

Thus, it appears to be improper to separate the product of Group I from the process for making the product of Groups II-V since these two are clearly connected by a single general inventive concept.

Even if the Examiner were to persist, however, in his belief that these groups of claims should be restricted, it is worth noting that the Manual of Patent Examining Procedure states at § 803:

If the searching and examination of an entire application can be made without serious burden, the Examiner is encouraged to examine it on the merits, even if it includes claims to distinct or independent inventions.

It is notable that the groups of claims listed by the Examiner are all contained within the same class and subclass, and a search of this single subclass therefore does not appear to be a "serious burden" on the Examiner. For these reasons Applicants believe that restriction is not proper, in view of the above remarks, and that said restriction requirement should be lifted.

Applicants believe that the Examiner's rejection of Claims 1-2 under 35 USC 112, first and second paragraphs, have been obviated by the herein attached amendment. Support for the recitation of "hydroxy-substituted lower alkyl groups or halogenated lower alkyl groups" in Claim 1 is found in the specification

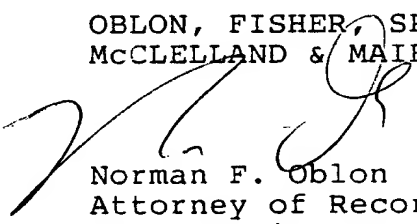
at page 5, lines 14-15. Claim 2 has been cancelled and replaced with dependant Claims 8-20 which recite the specific compounds claimed, as listed in Examples 1-18 in the specification.

The Examiner's objection to the Abstract under 37 CFR 1.72(b) has herein been corrected by the separate recitation of the abstract on a separate sheet of paper as herein attached.

Based upon the above, Applicants believe that the claims in this application are now in proper condition for allowance and an early notification of same is earnestly solicited.

Respectfully submitted,

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